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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,054	01/26/2001	Richard A. Mallo	56147USA8A.002	7236

7590 02/10/2003
Attention: Yen Tong Florczak
Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427

EXAMINER

FUBARA, BLESSING M

ART UNIT PAPER NUMBER

1615

DATE MAILED: 02/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,054

Applicant(s)

MALLO ET AL.

Examiner

Blessing M. Fubara

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 and 14 is/are allowed.
- 6) ☒ Claim(s) 1-8, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Examiner acknowledges receipt of amendment filed 11/13/02.

Claim Rejections - 35 USC § 102

1. Claims 1-4, 6-8, 11 and 12 remain rejected under 35 U.S.C. 102(b) as being anticipated by Chang (US 3,941,733).

Claim Rejections - 35 USC § 103

2. Claim 5 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 3,941,733).

Regarding the both rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a), applicants argue that Chang “does not teach or suggest cosmetic compositions of the present invention.”

3. Applicants' arguments filed 11/13/02 have been fully considered but they are not persuasive. The recitation of “cosmetic article” in claim 1 is an intended use for the claimed composition. Future intended use is not critical in a composition claim.

In response to applicant's argument that Chang “does not teach or suggest cosmetic compositions of the present invention,” and that “Chang fails to disclose or describe any compositions for cosmetic application,” a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) are reiterated below.

Chang teaches dispersions of poly(urethane-urea) terminated by hydrolysable or hydrolyzed silyl groups (abstract). The dispersion further comprises solubilizing groups, which are groups that ionize in water such as carboxyl, sulfate sulfonate, phosphonate and quaternary ammonium compounds (column 3, lines 1-6). Isocyanate, specifically diisocyanate, polymeric polyol, silyl compound, e.g. X_3Si -compound, ethylene glycol polyfunctional chain extender, and water solubilizing compound react to form polyurethane-urea dispersions in water (column 3, line 14 to column 4, line 4 and column 6, lines 26-31). Terminal silyl groups are listed in column 7, lines 11-25 and all but one are clearly the silyl groups recited in claim 7 of the instant invention. Ammonium carboxylates are disclosed as water-soluble thermoplastic compounds (column 7, lines 49-65).

Regarding claim 1, the use of the composition in cosmetic application or hair composition or stating that the composition is in the form of cosmetic article or composition is a future intended use and is not critical in a composition claim. Regarding claim 11, the polyurethane-urea polymer of the prior art would inherently the self-adhesive properties of the composition of the instant invention and thus form a film that would have a thickness of 0.025 mm when coated and dried because the prior art teaches the composition of the instant invention.

Chang clearly teaches the limitations of the instant claims.

Chang clearly teaches a polyurethane-urea terminated by hydrolysable or hydrolyzed silyl groups but fails to teach the molecular weight of the polyol. Since Chang is silent on the molecular weight of the polyol, Chang teaches all molecular weights. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare

composition of polyurethane-urea terminated by hydrolysable or hydrolyzed silyl groups and perform the chain extender reaction with polyols of all or any molecular weight because the silence in the prior art of the molecular weight of the polyol permits the use of polyol with any molecular weight. The use of a polyol that has a molecular weight in the range of about 200-5,000 is not inventive over the prior art in the absence of showing to the contrary.

4. Claims 13 and 14 are allowable because the prior art does not teach a composition comprising the specific hydrophilic cationic polymer recited in claims 13 and 14.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

Application/Control Number: 09/771,054
Art Unit: 1615

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is 703-308-8374. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Blessing Fubara
February 7, 2003

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600